



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------------|---------------------|------------------------|
| 10/520,794 | 01/10/2005 | Erik O. Martz | 525400-343 | 9963 |
| 7550 03/19/2010 | | | | |
| William Squire Carella Byrne Bain Gilfillan Cecchi Stewart & Olstein 5 Becker Farm Road Roseland, NJ 07068 | | EXAMINER RAMANA, ANURADHA | | |
| | | ART UNIT 3775 | | PAPER NUMBER |
| | | MAIL DATE 03/19/2010 | | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,794

Applicant(s)

MARTZ ET AL.

Examiner

Anu Ramana

Art Unit

3775

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 43-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 48-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notes of Informal Patent Application
- 6) ☐ Other: _____
- 7) ☐ Paper No(s)/Mail Date 1/10/05/4/3/09

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-42, 48 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation "the cutting edge being non-linear in shape in top plan view and having an apex in the top plan view, the cutting edge having first and second cutting coplanar portions in the first plane, each first and second edge portion tapering toward the proximal direction." renders the claim vague and indefinite since the structure being recited is unclear. The first and second edge portions lack antecedent basis.

In claim 4, the recitation "coextensive with said outer side surfaces juxtaposed with and beyond the blade apex." renders the claim vague and indefinite since the structural relationship between the guide member and the blade apex is not clearly recited.

In claim 6, the recitation "two of said blades" renders the claim vague and indefinite because "said blades" lacks antecedent basis.

In claim 15, the recitation "a pair of said blade" renders the claim vague and indefinite because the structure being claimed is unclear.

In claim 29, the recitation "the edges or a tangent thereto each lying in a second plane normal to the first plane, the second plane being inclined relative to the axis and relative to the opposing side surfaces in a direction toward the proximal end, the edges each having a portion in which the tangent thereto intersects a second side surface in top plan view at an acute angle." renders the claim vague and indefinite since the structure being recited is unclear. It is unclear which plane contains the tangent. Further, it is unclear which plane contains the top plan view. Also, the recitation "the

edges or a tangent thereto" renders the claim vague and indefinite since it is unclear whether the tangent touches both edges or one of the edges. The structure being claimed is unclear due to the use of "or."

In claim 42, the recitation "including a sleeve over the handle at the slot including a further slot juxtaposed with the handle slot" renders the claim vague and indefinite since it is unclear which slot is the handle slot. Further, the structural relationship between the sleeve and the handle is unclear due to the recitation "over the handle at the slot."

In claim 48, the recitation "extending from the shank proximal end coextensive with said peripheral side surfaces and juxtaposed with and beyond each of the blades." renders the claim vague and indefinite due to the phrase "and juxtaposed with and beyond each of the blades."

In claim 49, the recitation "and juxtaposed in mirror image relation" renders the claim vague and indefinite since the phrase is incomplete. The structure being recited is unclear.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 15, 25, 29, 39, 48-49, 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Rogers et al. (US 6840941).

Rogers et al. disclose a chisel including: a shank 509; a cutting blade with first and second blade portions (214, 216) attached to the proximal end of shank 509 wherein the blades have non-linear cutting edges with edge portions tapering towards the proximal end; and a handle 511 attached to the shank distal end. The first and second portions of the blade are symmetrical relative to the longitudinal axis of the shank. Rogers et al. further disclose a guide member 224 that extends beyond the blade apex (Figs. 1-2, 10-11, and 14, col. 4, lines 27-67, col. 5, col. 6, lines 1-6, col. 8, lines 66-67 and col. 9, lines 1-27).

Claims 50-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Jumashev et al. (US 4059115).

Jumashev et al. disclose a surgical instrument or chisel for preparing adjacent vertebrae including: a handle 2; a shank 1 having a hollow core; a chisel guide member 6 movably secured to the shank and having extended and retracted states; a head or "handle member" or knob 13 or "means coupled to the handle" for selectively retracting and extending the guide member 6; a rod 16 connected to the guide member 6 for axially displacing the guide member along the longitudinal axis of the shank; and detent means including a longitudinal slot in the handle and grooves axially spaced in communication with the slot for receiving lugs 14 (Fig. 1, col. 4, lines 47-68, cols. 5-6 and col. 7, lines 1-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. (US 6840941) in view of Rose (US 3803667).

Rogers et al. disclose all elements of the claimed invention except for a handle releasably attached to the shank distal end.

Rose teaches removable attachment of a chisel to a handle so that the chisel head can be made to be disposable (col. 2 and col. 2, lines 1-13).

Therefore, it would have been recognized by one of ordinary skill in the art at the time the invention was made that applying the known technique of providing a handle removably attached to a chisel shank, as taught by Rose, to the Rogers et al. device would have yielded predictable results, i.e., removable attachment of a handle to a shank so that the chisel head could be replaced when the blade portions lose their sharpness or become otherwise useless.

Allowable Subject Matter

Non-application of prior art indicates allowable subject matter, provided the claims are rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
March 15, 2010

/Anu Ramana/
Primary Examiner, Art Unit 3775